

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/179,405	10/27/98	KIM	K 1293.1050/MD

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EXAMINER	
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ART UNIT	PAPER NUMBER
2642	4

DATE MAILED:

04/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/179,405

Applicant(s)

Kim et al.

Examiner

Bill Deane

Group Art Unit

2642



☒ Responsive to communication(s) filed on Oct 10, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-19 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3&4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 17, note that claim 17 depends from claim 14. There is no disconnection in claim 14, so reestablishing a connection is indefinite. Note that claim 17 has received both a 102 and 103 rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1 - 4, 8 - 9, 11 - 19 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent No. 6,091,808 (Wood et al.).

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With respect to claim 1, Wood et al teach a number searching system comprising: a phone (10); a telephone database (42); a web server (34); an information terminal (see Col. 3, lines 49 - 55) which displays a searched for telephone number (see Fig. 3, element 68) and a telephone plug-in which automatically dials the displayed number (Compare page 6, lines 6 - 13 of the present invention with Col. 6, line 56 - Col. 7, line 5).

With respect to claim 2, note that a PC (Col. 3, line 50) is used and that the phone (10) is a telephone.

With respect to claim 3, see Col. 3, lines 55 - 57.

With respect to claim 4, see Col. 3, lines 58 - 68.

With respect to claim 7, 13 and 19, note Fig. 1, and line 14 and 18. See also Col. 6, lines 56 - 66. Clearly, if the switch is checking to see if the phone 10 is on hook, two lines are involved. If it was checking the same line as used by the PC or terminal to access the web then the switch would always get a busy signal.

With respect to claim 8, see the rejection of claim 1 and note the ability to enter search terms that correspond to telephone numbers (Col. 6, lines 32 - 34 and Fig. 3, element 68).

With respect to claim 9, note Col. 5, lines 62 - 65.

With respect to claim 11, note Col. 8, line 66 - Col. 9, line 14.

With respect to claims 12 and 16, if the system of Wood et al is integrated as taught at Col. 3, lines 55 - 57, then such steps are inherent.

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With respect to claim 14, see the rejection of claims 1 and 8 above. In addition, the link syntax is the hypertext tag (Col. 5, lines 62 - 65).

Claim 15, is inherent from the discussions above.

With respect to claim 17 (as best as can be determined) and in addition claim 18, as explained above, if the system was integrated then a disconnect from the web would be necessary before a call is placed over the same line. To get back to the web one would have to reestablish the connection. Nothing in the claim denotes that the step of reconnection is automatic or electronic rather than manual.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woods et al.

With respect to claim 10, Wood et al teach the use of a hypertext tag as discussed above. However, Wood et al do not teach the tag as being "<dialto> telephone</dialto>". It would have been obvious to one of ordinary skill in the art to use any tag that was deemed appropriate to automatically dial a phone number.

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7. Claims 5 - 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. in view of U.S. Patent No. 5,764,736 (Shachar et al.).

Wood et al teach the claimed device as discussed above except for the ability to disconnect from the web server upon dialing and then reestablishing the connection to the web server. However, Shachar et al teach that such a disconnect and reestablishing the connection is old in the art (see abstract, Col. 8, lines 40 - 43 and Col. 10, line 54 - Col. 11, line 6). It would have been obvious to one of ordinary skill in the art to have incorporated the ability to disconnect from the web server upon dialing and then reestablishing the connection to the web server as taught by Shachar et al into the system and methods of Wood et al as an old means of convenience to a user.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent No. 6,192,044 (Mack) - note Title, Abstract and Fig. 1;

U.S. Patent No. 6,178,183 (Buskirk, Jr.) - note Abstract and Fig. 4;

U.S. Patent No. 5,982,774 (Foladare et al.) - note ability to put Internet on hold; and

U.S. Patent No. 5,884,032 (Bateman et al.) - note Fig. 1.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bill Deane whose telephone number is (703) 306 - 5838. In addition, facsimile transmissions should be directed to Bill Deane at facsimile number (703) 308-6306.

WILLIAM J. DEANE, JR.
PATENT EXAMINER

William J. Deane Jr.

April 23, 2001